

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed June 23, 2005. At the time of the Office Action, Claims 1-32 were pending in the Application. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 102 Rejection

The Examiner rejects Claims 1-6 and 8-32 under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2004/0266426 issued to Marsh et al. (hereinafter "*Marsh*"). This rejection is respectfully traversed for the following reasons.

Once again Applicant respectfully reminds the Examiner that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.¹ In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim."² In regard to inherency of a reference, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic."³ Thus, in relying upon the theory of inherency, an Examiner must provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.⁴

Applicant understands the Examiner's rationale in using *Marsh*, but *Marsh* is not a panacea in supporting the Examiner's contention. *Marsh* is flawed in a number of respects and Applicant is confident in his ability to demonstrate the distinctions between *Marsh* and the pending subject matter. Independent Claim 1 recites an apparatus that includes the establishment of the signaling pathway being substantially concurrent with the establishment of one or more of the voice circuits such that one or more features associated with a private

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131.

² *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); MPEP §2131 (*emphasis added*).

³ MPEP §2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (*emphasis in original*)).

⁴ MPEP §2112 (citing *Ex Parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. at App. and Inter. 1990) (*emphasis in original*)).

network are delivered to the mobile station during the communication session. There are two important items to glean from this recitation: 1) the existence of separate legs for signaling and for voice; and 2) the delivery of private network features to the mobile station.

First, there is nothing in *Marsh* that offers such a two-pathway paradigm. Why this is the case is evident from *Marsh's* disclosure, which provides: "The legs 342D and 152C as well as the legs 342E and 152D are common to both the paths 152 and 342 and perform like functions in each path." (See *Marsh*, paragraph 0090.) Note that Applicant is citing portions of FIGURES 6 and 20 in making these arguments; these are the very FIGURES on which the Examiner has chosen to rely. Thus, there are no separate pathways for signaling and for voice, as any type of data can propagate on either leg. Indeed, the architecture of *Marsh* relies on the fact that there is no difference in these two legs.

Moreover, Applicant has reviewed the entire description of FIGURES 6 and 20 in hopes of finding any feature delivery capability for the mobile station. There is no feature delivery capability present. Note that *Marsh* attempts to mimic certain features (e.g. caller ID) by creating an 'artificial caller ID' (e.g. leveraging 'custom' signaling or tones, etc.). All of these operations are provided because there are no separate pathways for voice and signaling. In one sense, these more complicated operations disclosed by *Marsh* are provided to overcome its inability to optimally deliver features from the private network. While it is true that *Marsh* can facilitate a connection from a legacy platform to a dual mode subscriber device, *how* that is being done in *Marsh* is not akin to the operations circumscribed by the pending subject matter. Moreover, because of its configuration, *Marsh* can only provide a simple link for such a communication session involving the dual mode subscriber device, but not be able to deliver the features of the private network.

Note that the Examiner should appreciate the significance of a separate signaling pathway in an arrangement that is highlighted by the pending subject matter. The configuration of the present invention allows the enterprise system to establish a voice path between the private and public network using a voice network. The separate signaling path may enable enhanced signaling to deliver private network information to the mobile station by establishing a data connection from the IP PBX to the mobile station.

Therefore, while in the public wireless network, the mobile station is able to receive private network PBX features (e.g. shared lines, call pickup, group pickup, directory

functions, message waiting indicator, etc.) as if the mobile station were part of the IP PBX in the private network. *Marsh* cannot do this.

This ability allows the enterprise system to provide a common set of private network features to the mobile station regardless of whether the mobile station receives service from the private or public network. Such a scenario could not be facilitated without a separate signaling pathway. This feature further provides that a given end user does not sacrifice processing time or inhibit his own versatility in being able to enjoy the advantages of both systems. In addition, minimal overhead is incurred as a result of a modification to a given system in order to accommodate private and public network functions.

For at least these reasons, Independent Claim 1 is clearly patentable over *Marsh*.

Section 103 Rejection

The Examiner rejects Claim 7 under 35 U.S.C. §103(a) as being unpatentable over *Marsh*. This rejection is respectfully traversed for the following reasons.

Applicant respectfully reminds the Examiner that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations.⁵

It is respectfully submitted that the rejected claims are patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation of the Independent Claims. This issue has been evaluated extensively in the §102 analysis above. The proposed *Marsh* combination is flawed in that there is simply no disclosure of any separate signaling pathway, which is established substantially concurrent with the establishment of the voice circuits.

In addition, Independent Claims 8, 15, 21, and 27 recite a similar (but not an identical) limitation and, thus, are also allowable over this §103 combination using a similar

⁵ See M.P.E.P. §2142-43.

rationale. Additionally, using analogous reasoning, the corresponding dependent claims of these Independent Claims are also allowable over the references of record.

Accordingly, all of the pending claims have been shown to be allowable, as they are patentable over the cited references. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

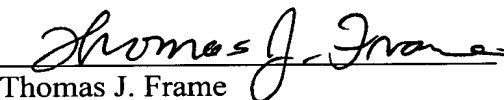
CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fee is due. However, if this is not the case, the Commissioner is hereby authorized to charge any amount required or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas Frame at 214.953.6675.

Respectfully submitted,
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Date: August 15, 2005

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